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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|-------------------------------|------------------|
| 09/875,237 | 06/06/2001 | Douglas F. Fry | U 0045 OS/TEAP | 7303 |
| 23657 | 7590 | 12/09/2004 | EXAMINER | |
| COGNIS CORPORATION PATENT DEPARTMENT 300 BROOKSIDE AVENUE AMBLER, PA 19002 | | | SANDERS, KRIELLION ANTIONETTE | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1714 | |

DATE MAILED: 12/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/875,237

Applicant(s)

FRY ET AL.

Examiner

Kriellion A. Sanders

Art Unit

1714

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 24 November 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 24 November 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See attachment.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:


Claim(s) allowed: none.

Claim(s) objected to: _____.

Claim(s) rejected: 1-30.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____


Kriellion A. Sanders
Primary Examiner
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ADVISORY ACTION

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

The following remarks are in response to applicant's comments submitted after the final rejection.

1. Claims 1-30 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-42 of U.S. Patent No. 6,399,741. Although the conflicting claims are not identical, they are not patentably distinct from each other.

2. Applicant's claims 1-11 are directed to a polymer derivative that is fully described in patentees' claims.

It is clear that the polyalkyleneimine polymers of the patent overlap with those of applicant's claims.

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3. Applicant's claim 1 recites a polymer derivative comprising a polyalkyleneimine backbone having a number of reactive amino functionalities, each reactive amino functionality having at least one reactive hydrogen atom, wherein about 20% to about 60% of the number of reactive amino functionalities have a substituent-compound substituted in place of the at least one reactive hydrogen atom each substituent-compound independently selected from the group consisting of carboxylic acids having from about 14 to about 20 carbon atoms.

4. Claim 1 of the patent recites, "a polymer derivative comprising a polyalkyleneimine backbone having a number of reactive amino functionalities, each reactive amino functionality having at least one reactive hydrogen atom, wherein a color stabilizing-effective amount of the number of reactive amino functionalities have a substituent-compound independently selected from the group consisting of carboxylic acids and amine-protecting compounds substituted in place of the at least one reactive hydrogen atom, and wherein at least about 20% of the reactive amino functionalities have a carboxylic acid substituted in place of the at least one reactive hydrogen atom.

Applicant's claim 1 recites that about 20% to about 60% of the number of reactive amino functionalities have a substituent-compound substituted in place of the at least one reactive hydrogen atom

5. Claim 1 of the patent states that at least about 20% of the reactive amino functionalities have a carboxylic acid substituted in place of the at least one reactive hydrogen atom.

6. Both the patented and present inventions suggest that "about 20% of the reactive amino functionalities have a carboxylic acid substituted in place of the at least one reactive hydrogen atom".


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7. There is clear overlap between the patented and presently claimed inventions. The claims define the metes and bounds of the invention.
8. Claim 4 of the patent recites that the carboxylic acids of claim 1 have from 2-18 carbon atoms.
9. Claim 1 of the application recites that the carboxylic acids have from 14-20 carbon atoms.
10. The presently claimed invention is not seen to be patentably distinct from the patented invention of Fry et al.
11. The clear overlap in the claim limitations of the patented and present claims render applicant's invention obvious.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kriellion A. Sanders whose telephone number is 571-272-1122. The examiner can normally be reached on Monday through Wednesday 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2351.


Kriellion A. Sanders
Primary Examiner
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December 6, 2004